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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,344	10/24/2000	Seishi Ejiri	1232-4303US2	9182

27123 7590 07/14/2005  
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EXAMINER

MANIWANG, JOSEPH R

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/694,344

Applicant(s)

EJIRI, SEISHI

Examiner

Joseph R. Maniwang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 18-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 101***

2. Claims 18-27 and 38-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
3. Regarding claims 18-21, "A data processing apparatus comprising: a reception unit...; a notification unit...; a transmission unit...; a selection unit...; a determining unit...; wherein said transmission unit, in the first mode, transmits..." is non-statutory, since it is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. This is true even if the various "units" include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware.
4. Regarding claims 22-27, "A data processing apparatus comprising: a reception unit...; a notification unit...; a transmission unit...; a setting unit..." is non-statutory, since it is not tangibly embodied in a manner so as to be executable as the only hardware is in an intended use statement. This is true even if the various "units" include hardware, since it is the intent of the execution of the system and not the system itself that includes such hardware.

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5. Regarding claims 38-41, "A computer-readable medium encoded with a computer-readable program to be used by a data processing apparatus, the program when executed by the data processing apparatus performing processes comprising: a reception step...; a notification step...; a transmission step...; a selection step...; a determining step..." would normally be considered statutory unless the specification defines "computer readable medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, the Specification defines the computer readable medium as including program code(s) executed by the data processing apparatus (see Specification, p. 29, line 27 through p. 31, line 27), which is non-statutory subject matter.

6. Regarding claims 42-47, "A computer-readable medium encoded with a computer-readable program to be used by a data processing apparatus, the program when executed by the data processing apparatus performing processes comprising: a reception step...; a notification step...; a transmission step...; a setting step..." would normally be considered statutory unless the specification defines "computer readable medium" as including intangible media such as signals, carrier waves, transmissions, optical waves, transmission media or other media incapable of being touched or perceived absent the tangible medium through which they are conveyed. In this case, the Specification defines the computer readable medium as including program code(s)

executed by the data processing apparatus (see Specification, p. 29, line 27 through p. 31, line 27), which is non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

7. Claims 18-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (U.S. Pat. No. 5,459,584), hereinafter referred to as Gordon.

8. Regarding claims 18, 28, and 38, Gordon disclosed a method and system comprising a reception unit adapted to receive data designated to a plurality of receivers, from a transmission side (see column 6, lines 31-37); a notification unit adapted to notify the plurality of receivers that said reception unit received the data (see column 4, lines 60-63); a transmission unit adapted to transmit information representing a notification result by said notification unit, to the transmission side from which the data received by said reception unit was transmitted (see column 3, lines 18-22; column 5, lines 58-64; column 8, lines 54-59; column 8, line 66 through column 9, line 12; column 15, lines 16-25; column 20, lines 18-30); a selection unit adapted to select one of a first mode and a second mode (see column 10, lines 10-16, 27-34); and a determining unit adapted to determine whether a predetermined time has been reached or not (see column 9, lines 13-40); wherein said transmission unit, in the first mode, transmits one by one information representing the notification results corresponding to each of receivers by said notification unit regardless of a determination by said determining unit, and in the second mode, transmits collectively the information representing the notification results for the receivers by said notification unit at the time when said

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determining unit determines that the predetermined time has been reached (see column 10, lines 10-26, 27-34; column 12, lines 2-4).

9. Regarding claims 19, 29, and 39, Gordon disclosed the method and system wherein in a case where the first mode is selected by said selection unit, said transmission unit transmits the information representing the notification result for one receiver at one communication (see column 3, lines 29-36; column 10, lines 27-34).

10. Regarding claims 20, 30, and 40, Gordon disclosed the method and system wherein said notification unit notifies the receivers which are designated by the transmission side that said reception unit received the data (see column 4, lines 60-63).

11. Regarding claims 21, 31, and 41, Gordon disclosed the method and system wherein a case where the notification by said notification unit was successful is a state where the receiver can obtain the data (see column 4, lines 56-67; column 14, line 1 through column 15, line 15).

12. Regarding claims 22, 32, and 42, Gordon disclosed a method and system comprising a reception unit adapted to receive data designated to a receiver, from a transmission side (see column 6, lines 31-37); a notification unit adapted to notify the receiver that said reception unit received the data (see column 4, lines 60-63); a transmission unit adapted to transmit information representing a notification result by said notification unit, to the transmission side from which the data received by said reception unit was transmitted (see column 3, lines 18-22; column 5, lines 58-64; column 8, lines 54-59; column 8, line 66 through column 9, line 12; column 15, lines 16-25; column 20, lines 18-30); a setting unit adapted to set whether the transmission of

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the information representing the notification result by said transmission unit based on an instruction by said data processing apparatus side is to be permitted or not (see column 10, lines 14, 27-34), wherein a setting result by said setting unit is notified to the transmission side, and wherein said transmission unit does not transmit the information representing the notification result until said reception unit receives a request from the transmission side from which the data received by said reception unit was transmitted in a case where said setting unit sets the transmission is not to be permitted (see column 10, lines 14, 27-34), and transmits the information representing the notification result even without the request from the transmission side in a case where said setting unit set the transmission is to be permitted (see column 9, lines 30-40; column 10, lines 10-16).

13. Regarding claims 23, 33, and 43, Gordon disclosed the method and system wherein said setting unit sets one of a first mode and a second mode and said transmission unit performs the transmission in accordance with the mode set by said setting unit (see column 10, lines 10-16, 27-34; column 12, lines 2-4).

14. Regarding claims 24, 34, and 44, Gordon disclosed the method and system wherein in the first mode, said transmission unit transmits one by one the information representing the notification results for a plurality of receivers by said notification unit by plural-time communications (see column 3, lines 29-36; column 10, lines 27-34), and in the second mode said transmission unit transmits collectively the information representing the notification results for a plurality of receivers by said notification unit by one-time communication (see column 10, lines 10-16; column 12, lines 2-4).

15. Regarding claims 25, 35, and 45, Gordon disclosed the method and system wherein said transmission unit generates a call on the basis of destination information included in the data received by said reception unit (see column 11, lines 18-27).

16. Regarding claims 26, 36, and 46, Gordon disclosed the method and system wherein said notification unit notifies the receiver which is designated by the transmission side that said reception unit received the data (see column 4, lines 60-63).

17. Regarding claims 27, 37, and 47, Gordon disclosed the method and system wherein a case where the notification by said notification unit was successful is a state where the receiver can obtain the data (see column 4, lines 56-67; column 14, line 1 through column 15, line 15).

### ***Response to Arguments***

18. Applicant's arguments filed 04/05/05 have been fully considered but they are not persuasive.

19. Regarding claims 38-47 rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter, Examiner submits that the amendment to the claims are insufficient in overcoming the rejections. The recitation "A computer-readable medium encoded with a computer-readable program" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to



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stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Furthermore, Examiner submits that while the claim is initially direct to a computer-readable medium, the claim limitations recite method steps of a software program and therefore are not tangibly embodied in a manner so as to be executable, and that the only hardware mentioned in the claim is in an intended use statement.

20. Regarding claims 18-47 rejected under 35 U.S.C 102(e) as being anticipated by Gordon et al. (U.S. Pat. No. 5,459,584), hereinafter referred to as Gordon, Applicant traverses the rejection asserting that Gordon does not teach the limitations as claimed. Specifically, Applicant asserts that Gordon does not teach a first transmission mode involving one-by-one transmission of information representing the notification results corresponding to each of receivers as recited in claims 18, 28, and 38. However, Examiner submits that this broadly claimed limitation is taught by Gordon, where it was disclosed that the status of a single given message identified by a Message Code could be transmitted to a transmission side either in the form of voice or as a written record (see column 10, lines 27-34).

21. Applicant further asserts that Gordon does not teach a setting feature to set whether transmission of the information representing the notification result is to be permitted or not as recited in claims 22, 32, and 42. Applicant states that it is apparent that the request for information is different than the setting or notification of the setting to permit or not permit transmission of information. However, it is unclear as to how such reasoning is apparent, as Applicant has not provided further details. Examiner submits

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that a setting feature for setting whether notification transmission is permitted or not is a broad concept which requesting whether or not transmission of a notification is permitted or not reads upon. The provision to dial a request for a notification is functionally the same as the claimed invention, described by Applicant to not transmit a notification "until the request from the transmission side is received".

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph R. Maniwang whose telephone number is (571) 272-3928. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

MARC D. THOMPSON  
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PRIMARY EXAMINER